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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,737	08/27/2001	Cheng-Hao Chou	005694.P069	5143

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EXAMINER

VO, NGUYEN THANH

ART UNIT	PAPER NUMBER
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2685

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DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,737

Applicant(s)

CHOU, CHENG-HAO

Examiner

Nguyen T Vo

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 7-10, 18-23 and 29-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-17 and 24-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention: group I including **claims 1-6, 11-17, 24-28**, drawn to the components of a SIM card backup system; group II including **claims 7-10, 18-23, 29-32**, drawn to a method for operating a SIM card backup system.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there is no generic claim.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Clement Cheng on 09/17/2004 a provisional election was made with traverse to prosecute the invention of group I, claims **1-6, 11-17, 24-28**. Affirmation of this election must be made by applicant in replying to this Office action. Claims **7-10, 18-23, 29-32** are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herzog (6,353,737) in view of Verstijnen (5,733,147) and Japanese document 63-168755.

As to claim 1, Herzog discloses a SIM card system having a SIM card connector (see the connection between SIM card and card read IF in figure 1) in order to transfer a

first storage data of said SIM (see column 4 lines 27-35), a central processing unit (see the processor discussed at column 5 lines 18-28), a memory RAM, a display LCD for showing the first storage data after the treat from the processor unit (see column 4 lines 37-46; column 5 line 46 to column 6 line 22), a power supply (inherently included in order to supply power to the components of the mobile station MS), an inputting device KBD for inputting or changing a second storage data to the SIM card system (see column 5 lines 24-26, lines 34-36, lines 53-57). Herzog fails to disclose that the connector is mounted on a printed circuit board, which accommodates a SIM card. Verstijnen discloses a connector which is mounted on a printed circuit board to accommodate a SIM card (see column 1 lines 44-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Verstijnen to Herzog, in order to obtain a connector that is compact and cost-effective and use minimize surface area on the printed circuit board (as suggested by Verstijnen at column 1 lines 40-47).

Still regarding claim 1, the combination of Herzog and Verstijnen fails to disclose that the SIM card system is a SIM card backup system as claimed. Japanese document discloses memory card backup system (see the English translation). The backup system comprises a memory for reading, writing and storing results in access times (see the memory in the holder). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of the Japanese document to the combination of Herzog and Verstijnen, in order to obtain a reliable memory backup for the SIM card (as suggested by the Japanese document).

Still regarding claim 1, the combination of Herzog, Verstijnen and Japanese document does disclose a memory (see the memory in the holder of the Japanese document). The above combination, however, fails to expressly disclose that the memory is a serial data memory. The examiner, however, takes Official Notice that serial data memory is known in the art, and such a memory can be used in the above combination without changing the scope and spirit of the invention of the combination. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the conventional serial data memory in the above combination, in order to reduce the cost of the memory.

As to claims 2-3, 14-15, the combination of Herzog, Verstijnen and Japanese document does disclose a memory (see the memory in the holder of the Japanese document). The above combination, however, fails to disclose that the memory comprises a flash memory, or a EEPROM. The examiner, however, takes Official Notice that a flash memory and EEPROM are known in the art, and such memories can be used in the above combination without changing the scope and spirit of the invention of the combination. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the conventional flash and EEPROM memories in the above combination, in order to reduce the system complexity because it employs already-existing memories.

As to claims 4, 16, the above combination discloses a LCD (see the LCD in figure 1 of Herzog).

As to claim 5, the combination of Herzog, Verstijnen and Japanese document does disclose a display (see the display in Herzog). The above combination, however, fails to disclose that the display comprises a LED display. The examiner, however, takes Official Notice that a LED display is known in the art, and such a display can be used in the above combination without changing the scope and spirit of the invention of the combination. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the conventional LED display in the above combination, in order to reduce the system complexity because it employs already-existing display.

As to claims 6, 17, the above combination discloses a keypad KBD (see the KBD in figure 1 of Herzog; see also column 5 lines 23-25).

As to claim 11, first of all the rejection to claim 1 above is hereby incorporated by reference. In addition, the above combination of Herzog, Verstijnen and Japanese document further discloses a telecommunication device with means for communicating (see RP unit in figure 1 of Herzog; see also column 5 lines 18-28).

As to claim 12, the above combination of Herzog, Verstijnen and Japanese document further discloses a telephone (see Herzog, column 5 lines 18-28; column 6 lines 1-4, lines 63-65).

As to claim 13, the above combination of Herzog, Verstijnen and Japanese document further discloses a telephone (see Herzog, column 5 lines 18-28; column 6 lines 1-4, lines 63-65).

5. Claims 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herzog (6,353,737) in view of Verstijnen (5,733,147) and Japanese document 63-168755, and Erola (6,092,133).

As to claim 24, first of all the rejection to claim 1 above over the combination of Herzog, Verstijnen and Japanese document is hereby incorporated by reference. In addition, the above combination discloses using the SIM backup system in a mobile telephone instead of a PDA as claimed. Erola discloses SIM card can be used in a mobile telephone or a PDA (see column 11 lines 6-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the SIM card backup system in Erola, in order to obtain a multi-purpose mobile communication device (as suggested by Erola at column 11 lines 6-17).

As to claim 25, the combination of Herzog, Verstijnen, Japanese document and Erola does disclose a memory (see the memory in the holder of the Japanese document). The above combination, however, fails to disclose that the memory comprises a flash memory. The examiner, however, takes Official Notice that a flash memory is known in the art, and such memories can be used in the above combination without changing the scope and spirit of the invention of the combination. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the conventional flash memory in the above combination, in order to reduce the system complexity because it employs already-existing memories.

As to claim 26, the above combination discloses a LCD (see the LCD in figure 1 of Herzog).

As to claim 27, the above combination discloses a keypad KBD (see the KBD in figure 1 of Herzog; see also column 5 lines 23-25).

As to claim 28, the combination of Herzog, Verstijnen, Japanese document and Erola does disclose an inputting device (see the keypad KBD in figure 1 of Herzog). The above combination, however, fails to disclose that the inputting device comprises a touch screen panel as claimed. The examiner, however, takes Official Notice that a touch screen panel is known in the art, and such a touch screen panel can be used in the above combination without changing the scope and spirit of the invention of the combination. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the conventional touch screen panel in the above combination, in order to reduce the system complexity because it employs already-existing touch screen panels.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Uehara (US 2002/0160808) discloses transferring data between two SIM cards.

Shimada (US 2004/0124238) discloses information processing apparatus with a memory card.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nguyen T Vo whose telephone number is (703) 308-6728. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (703)305-4385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen Vo



9-25-2004

NGUYEN T. VO
PRIMARY EXAMINER